

In the Request for Reconsideration filed September 6, 2002, Applicants noted that U.S. Patent No. 5,715,173, which was cited on page four of the Office Action dated June 6, 2002, was not listed in the Notice of References Cited (PTO-892). This omission has not been corrected. Applicants, therefore, respectfully request that the Examiner clarify the record by acknowledging citation of U.S. Patent No. 5,715,173 by issuing a Notice of References Cited that includes U.S. Patent No. 5,715,173.

Applicants also note that the Supplemental Information Disclosure Statement and cited art filed April 15, 2002, have not been acknowledged. Enclosed herewith are copies of the Information Disclosure Statement, PTO-1449 Form and stamped return postcard acknowledgement. Applicants hereby respectfully request that the Examiner clarify the record by acknowledging receipt of the Information Disclosure Statement filed April 15, 2002, and that the Examiner provide an appropriately initialed copy of the PTO-1449 form indicating consideration of the cited prior art.

**CLAIMS 1-4 AND 7 ARE REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF
DOUBLE PATENTING IN VIEW OF CLAIMS 1, 3-5 AND 9 OF U.S. PATENT NO. 6,472,357
(HEREINAFTER THE '357 PATENT)**

In the second enumerated paragraph of the Office Action, the Examiner asserted that the claimed compound "is the same as the electronic parts cleaning solution in claim 1 of US 6,472,357." This rejection is respectfully traversed.

Initially, Applicants note that claims 5 and 6 were not mentioned in the statement of the rejection (see page 2 of the Office Action). However, claims 5 and 6 were later referred to in pages 3 and 4 of the Office Action as being rejected. As such, Applicants assume that the Examiner also intended to reject claims 5 and 6 under the doctrine of double patenting.

Applicants respectfully submit that the Examiner has failed to establish that the claimed cleaning agent for a semiconductor device recited is obvious in view of the electronic parts cleaning solution disclosed by claim 1 of the '357 patent. In this regard, the Examiner is referred to M.P.E.P. § 804(II)(B)(1), entitled "Obviousness-Type," which states:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type patenting analysis ...

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim in the application; and

(B) The reasons why a person having ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the patent.

The Examiner has not performed such an analysis. Instead, the Examiner has merely pointed out that the claimed cleaning agent for a semiconductor device and the electronic parts cleaning solution disclosed by claim 1 of the '357 patent share a common compound. This analysis, however, falls short of the requirements necessary to establish that the claimed cleaning agent would have been obvious in view of the electronic parts cleaning solution disclosed by claim 1 of the '357 patent.

Not only has the Examiner failed to establish that the claimed cleaning agent for a semiconductor device would have been obvious in view of the electronic parts cleaning solution

disclosed by claim 1 of the '357 patent, the Examiner is also required to establish that the electronic parts cleaning solution disclosed by claim 1 of the '357 patent would have been obvious in view of the cleaning agent for a semiconductor device recited in claim 1. In this regard, the Examiner is referred to M.P.E.P. § 804(II)(B)(1)(b), entitled "Two-Way Obviousness." A two-way test occurs when the patent is the later filed application and Applicants could not have filed the claims in a single application and there is administrative delay.¹

The present application was filed on October 4, 2002, whereas the '357 patent was filed February 2, 2001. Thus, the '357 patent is the later filed application. Furthermore, Applicants could not have filed the claims in a single application. Claim 1 of the '357 patent includes limitations directed to a tungsten corrosion inhibitor or a copper corrosion inhibitor having various characteristics. As these limitations were neither taught nor suggested by the disclosure of the present application, the present application could not have properly enabled all the limitations of claim 1 of the '357 patent. Therefore, Applicants could not have filed the claims in a single application. This situation is considerably different from the factual situations in In re Berg, in which the court stated that "[t]he specification of the [] patent and application are practically identical," and In re Goodman², in which the issued patent was a continuation of the application.

Applicants also submit that administrative delay on the part of the Patent Office caused the later-filed '357 patent to issue prior to the present application. The '357 patent was filed four

¹ In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998).

² 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

months after the filing of the present application. The Patent Office did not issue a first Office Action on the merits for the present application until June 6, 2002. Thus, the first Office Action on the merits for the present application was mailed approximately 20 months after filing. In contrast, the '357 patent issued 21 months after filing. Thus, a Notice of Allowance was issued and the issue fee was paid in the '357 patent months well before the first Office Action on the merits was mailed in the present application. Given these circumstances, it is clear that administrative delay on the part of the Patent Office caused the later-filed '357 patent to issue prior to present application.

Applicants, therefore, respectfully submit that the Examiner is also required to make a two-way determination of obviousness. As stated in M.P.E.P. § 804(II)(B)(1)(b):

When making a two-way obviousness determination where appropriate, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Therefore, in addition to being required to establish that the claimed cleaning agent for a semiconductor device would have been obvious in view of the electronic parts cleaning solution disclosed by claim 1 of the '357 patent, the Examiner is also required to establish that the electronic parts cleaning solution disclosed by claim 1 of the '357 patent would have been obvious in view of the cleaning agent for a semiconductor device recited in claim 1.

With regard to this additional test, Applicants note that the invention recited in claim 1 of the '357 patent includes a "metal corrosion inhibitor" as an essential feature. This corrosion

inhibitor, however, is not disclosed by claim 1 of the present application. The '357 patent also describes that the metal corrosion inhibitor and a "specific ether compound" can perform efficient washing while suppressing erosion of silicon and a metal other than silicon (column 1, lines 44-55). In particular, the '357 patent describes that, by adding the metal corrosion inhibitor, erosion of a metal can be prevented (column 3, lines 54-55). Tables 1 and 2 clearly show a decrease in the etching speed of a metal (tungsten or copper). In contrast, the present application neither discloses nor suggest the metal corrosion inhibitor or the resulting effect therefrom. Thus, the invention recited in claim 1 of the '357 patent would not have been obvious in view of the claims of the present application. Therefore, a rejection of claim 1 under the judicially created doctrine of double patenting in view of claims 1, 3-5 and 9 of the '357 patent is not proper, and Applicants respectfully solicit withdrawal thereof. Dependent claims 2-7 are also patentable based upon their dependency upon claim 1.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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